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09/687,794	10/12/2000	Matthew Parrish	10002096-1	8526

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EXAMINER

DUONG, OANH L

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 11/10/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/687,794

Applicant(s)

PARRISH ET AL.

Examiner

Oanh L. Duong

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1, 9, 18 and 21 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The features "the command causing the web user computer to execute the web page file" lacks supported in the specification. The text in the specification in page 7 lines 6-12 discloses " Web tool inserts...a BIT tag...the browser executes the BIT tag, which causes it to transmit the BIT URL to ...server." For the purpose of examination, examiner assumes the command in the claimed invention is equivalent to BIT tag in Applicants' specification. Nowhere in the specification mentions the BIT tag causing the web user computer to execute the web page file.

***Response to Arguments***

2. Applicant's arguments filed 08/26/2003 have been fully considered but they are not persuasive.

In response to Applicants' argument that Kirsch does not provide for a command. The examiner has given the broadest reasonable interpretation of the command in view of the specification of the invention (BIT tag ...this tag is an image tag) (see page 7 lines 27-28). Thus, Kirsch does teach a command (e.g., see col. 12 lines 13-14).

In response to applicants' argument that nothing in Kirsch teaches or suggests using a BIT tag. Examiner respectfully disagrees because Kirsch does teach this limitation. As a citation above, BIT tag is an image tag (see page 7 lines 27-28); therefore, Kirsch still teaches BIT tag limitation as claimed (e.g., see col. 10 lines 5-15).

In response to Applicants' argument that nothing in Kirsch teaches or suggests storing user information in an error log. Examiner respectfully disagrees because Kirsch does teach this limitation. Kirsch teaches the user information is stored in an error log (read as database) within the designated server (e.g., see col. 11 lines 39-45). Both error log in Applicants' claim 5 and database in the system of Kirsch are used to store user information; therefore, Kirsch still teaches subject matter broadly recited in Applicants' claim 5.

In response to Applicants' argument that Kirsch does not teach a request to retrieve an image file from a designated server. Examiner respectfully disagrees because Kirsch does teach this feature. Kirsch teaches a request for retrieving an image file (...particular graphic image ...served to client system) (e.g., see col. 8 lines 36-40 and col. 8 line 63-col. 9 line 12).

In response to Applicants' argument that neither Kirsch nor Morimoto teach or suggest the use of an error for the purposes of intentionally recording user information.

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-5, 8-9, 12, 14-17 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by (Kirsch) (US 6,466,966 B1).

Regarding claims 1, 9 and 21, Kirsch teaches a method for tracking the use of a web tool by a web user (e.g., see col. 5 lines 8-27), comprising providing a web user through a web user computer access to a web tool (e.g., see col. 1 lines 52-56);

transmitting from the user web tool to the web user computer one or more web page files in connection with the user accessing the web tool (e.g., see col. 1 lines 56-64); inserting within at least one of the web page files, using the web tool, a command having embedded user information associated with the web user's use of the web tool (e.g., col. 6 lines 38-61 and col. 8 lines 19-45), the command causing the web user computer to execute the web page file and transmit directly to a server, designated within the command, a request that includes the embedded user information (e.g., see abstract, col. 7 lines 6-23 and col. 8 lines 19-40), wherein user information is stored in a database in response to the request being processed by a designated server (e.g., see col. 11 lines 4-45).

Regarding claims 2, 3 and 12, Kirsch teaches the command comprises mark up language image tag with the user information embedded in a URL (e.g., see col. 12 lines 5-15 and col. 8 lines 19-40).

Regarding claim 4, Kirsch teaches web tool is provided to a plurality of web users with each user receiving at least one web page having a command with embedded user information, wherein the user information for each user is transmitted to the designated server (e.g., see abstract, col. 7 lines 6-23 and col. 8 lines 19-40)

Regarding claim 5, Kirsch teaches user information is stored in a file within the designated server (e.g., see col. 11 lines 39-45).

Regarding claim 8, Kirsch teaches inserting the command in the at least one web page file so that it causes no error graphic to be displayed to the user in response to an image file designated with the command not being retrieved (e.g., see col. 8 line 63-22).

Regarding claim 14, Kirsch teaches a module for storing the user information in the database (e.g., see col. 11 lines 39-45).

Regarding claim 15, Kirsch discloses an image tag that is implemented with mark-up language tag (e.g., see col. 12 lines 1-15).

Regarding claim 16, Kirsch discloses HTML image tag (e.g., see col. 12 lines 13-14).

Regarding claim 17, Kirsch teaches Web tool server and designated server are implemented in the same server (e.g., see col. 5 lines 11-27).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6, 7, 10, 11, 13 and, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirsch in view of Morimoto at al (Morimoto) (US 6,397,244).

Regarding claims 6, 7, 11 and 13, Kirsch teaches the request is a request for retrieving an image file from the designated server (e.g. see col. 8 lines 36-40 and col. 8 line 63-col. 9 line12). Kirsch does not explicitly teach an Internet program as claimed. However, Morimoto teaches an Internet program with an error log (see col.5 lines 12-49 and col. 8 lines 27-45). Therefore, it would have been obvious to have used the program in Kirsch as taught by Morimoto because such program would enable error

analysis information to be utilized for analysis of the cause of an error upon occurrence of error.

Regarding claim 10, Kirsch does not explicitly teach database as claimed. However, Morimoto teaches database is an error log (see fig. 1 col. 5 lines 12-15). Therefore, it would have been obvious to have used database in Kirsch as taught by Morimoto because such database would provide the data file for storing error analysis information to be utilized for analysis of the cause of an error upon occurrence of error.

Regarding claims 18, Kirsch teaches a web tool system having capacity of tracking a user's use of a web tool (e.g., see col. 5 lines 8-27), comprising a web tool server communicatively linked to a web user computer for providing a web user with access to a web tool (e.g., see col. 1 lines 52-56), the web tool server having a web tool program for generating and providing to the web user computer one or more web page files in connection with the web user engaging a session with the web tool (e.g., see col. 1 lines 56-64); and a user information database server commutatively linked to the designated server (see fig. 2), wherein the web tool program inserts into at least one of the web page files a command having embedded user information associated with the web user's use of the web tool (e.g., col. 6 lines 38-61 and col. 8 lines 19-45), the command causing the web user computer to transmit to a server, designated within the command, a request that includes the embedded user information (e.g., see abstract, col. 7 lines 6-23 and col. 8 lines 19-40), wherein the user information is stored in a database in response to the request being processed by the designated server (e.g., see col. 11 lines 4-45). Kirsch does not explicitly teach a web server with an error log.



However Morimoto teaches a web server with an error log (see col. 5 lines 12-15), Therefore, it would have been obvious to have used web server with an error log in Kirsch as taught by Morimoto because such an error log would provide the data file for storing error analysis information to be utilized for analysis of the cause of an error upon occurrence of error.

Regarding claim 19, Kirsch discloses transferring user information into the user information database (e.g., see col. 9 lines 8-12 and col. 11 lines 39-45).

Regarding claim 20, Kirsch teaches image tag (e.g., see col. 12 lines 13-14).

**5. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2155

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Oanh L. Duong whose telephone number is (703) 305-0295. The examiner can normally be reached on Monday- Friday, 8:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on (703) 308-6662. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



O.D  
November 4, 2003

  
**HOSAIN ALAM**  
**SUPERVISORY PATENT EXAMINER**